

No. 12885

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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CONSOLIDATED VULTEE AIRCRAFT CORPORATION, a Delaware corporation, and AMERICAN AIRLINES, INC., a Delaware corporation,

*Appellants,*

*vs.*

MAURICE A. GARBELL, INC., a California corporation, and GARBELL RESEARCH FOUNDATION, a California corporation,

*Appellees.*

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REPLY BRIEF OF APPELLANTS.

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## REPLY BRIEF OF APPELLANTS.

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### Introduction.

This is in reply to the Brief of Maurice A. Garbell, Inc., *et al.*, filed in this action. Most of appellees' principal contentions are answered by our Opening Brief. However, Appellees' Brief raises several points that appear to merit a reply or comment. While many of the factual statements made in Appellees' Brief are unsupported in the evidence, or misleading, such errors are largely self-revealing, and we are content with the following reply.\*

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\*Unless otherwise noted, all emphasis in this brief is ours.

## The Claims Do Not Cover the Alleged Invention.

In an obvious attempt to avoid the prior art, Appellees' Brief (pp. 7-8) defines the alleged invention of the patent in suit, without regard to the claims in suit, as follows:

“The patent in suit specifically describes that in order to achieve the Garbell Stall the semispan of a wing should have three or more control sections and these three control sections *must have* a definite relationship to one another. This relationship is:

1. The root control section *must have* the least mean-line camber and the greatest thickness ratio of the entire wing;

2. The tip control section *must have* the greatest mean-line camber and the smallest thickness ratio of the entire wing; and

3. There *must be* at least one interjacent control section between the root and the tip and this section *must have* a greater mean-line camber than the root section and a smaller mean-line camber than the tip section, and the mean-line camber of the interjacent control section *should be* greater than that which would be derived from straight-line fairing from the root section to the tip section, and the thickness ratio of the interjacent control section *should be* smaller than that of the root section and greater than that of the tip section, but smaller than would be derived from straight-line fairing from root section to tip section.”

Much the same definition is given elsewhere in Appellees' Brief (*see*: pp. 9 and 20).

*If* we assume that appellees' definition of the alleged invention of the patent in suit is correct, all of the claims in suit are plainly fatally incomplete and invalid, as they

fail to “distinctly claim the part, improvement, or combination which he claims as his invention or discovery,” as required by Section 33 of Title 35, United States Code. None of the claims in suit, obviously, covers the alleged invention so defined by appellees. Claims 1, 2 and 3 of the patent in suit say *nothing whatever* about “thickness ratio” of *any* of the airfoil sections; and claims 5, 6 and 12 say *nothing whatever* as to the “mean-line camber” of the “*interjacent*” sections. If the designated relationships of *both* camber and thickness ratios are *essential* to the invention of the patent in suit, as stated in Appellees’ Brief, *supra*, plainly the claims in suit are fatally deficient for failing to define both relationships. Obviously, the wing defined by claims 1, 2 and 3 in suit can have *straight-line fairing* from root to tip so far as “thickness ratio” is concerned, and the wing defined by claims 5, 6, and 12 in suit can have *straight-line fairing* from root to tip so far as “mean-line camber” is concerned. All of the claims clearly cover far more than the alleged invention, and are all wholly indefinite in each case to at least one of the relationships (either camber or thickness ratio) which appellees say are all *essential* to the alleged invention. All of the claims are therefore clearly invalid. (See: *Goodman v. Super Mold Corp. of Calif.*, 103 F. 2d 474, 480 (C. C. A. 9th, 1939); *Crampton Mfg. Co. v. Crampton*, 153 F. 2d 543, 544 (C. C. A. 6th, 1946); *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477, 55 S. Ct. 455, 79 L. Ed. 1005 at 1012; *Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162 at 165.)

Furthermore, this self-serving definition, obviously for escaping from some of the prior art, imports the stated relationship as a necessity for stall achievement in direct *contradiction* of the specification which states (Col. 4, lines

51-59) that the interjacent station may have any camber *not exceeding* the tip section or *below* the *camber* of the root. These equal cambers are not the least or greatest of the entire wing within the definition, but are asserted to achieve the same result. That contradiction imparts to the patent the vice of misrepresentation as to what is essential. The patentee is bound by the representations in the patent. If too broad the patentee's remedy is by filing a disclaimer.

This self-serving definition into the claims imports another fatal inadequacy or insufficiency as defining the essential for producing the so-called Garbell stall or *any* specific stall. There is not the slightest clue: In the greater camber specified in claim 1; the "at variance" camber specified in claims 2 and 3; in the thickness variations specified in claims 5, 6 and 12; which are the *sole* purported changes asserted for novelty in the claims individually, which point to the production of any *specific* character of stall. *Increase* camber cannot produce the same result as *decrease*. *Increase* in thickness cannot produce the same result as *decrease*. Each of the individual changes is reflected in a difference in result. There is not the slightest clue in the claims to the spanwise locations of the changes, or of the extent of the changes, all of which are factors in the production of stall characteristics. There must be camber and thickness changes of a definite kind in degree and in a specific spanwise location to produce any specific stall, such the so-called Garbell stall or others, and the obvious insufficiency, indefiniteness and vagueness of the claims, make it impossible to find in them a definition of a construction for producing *any specific*, or the alleged "Garbell," stall. The conclusion is inescapable that the claims do not and were not intended to define a construction which produces any *particular* stall.



## The Patent in Suit Does Not Fulfill Any Long-Felt Want.

Appellees' Brief (pp. 3-6) asks this Court to believe that, prior to the alleged invention of the patent in suit, there was no airplane having a tapered wing which had satisfactory stall characteristics. This, we suggest, is not supported by the evidence. This Court may take judicial notice of the fact that, for many years prior to the alleged invention here in suit, there were thousands upon thousands of aircraft flying in the United States by individuals, commercial airlines, and the military, all of which were satisfactory. This is confirmed in the evidence by the thousands of Vultee Vengeance, Glen L. Martin, and Vultee airplanes which were shown to have been generally satisfactory as to stall characteristics.

Appellees' Brief (pp. 5-6, 30) asserts that there was a long-felt need in the art for an aircraft wing design which would stall satisfactorily. Even if this were true (which we deny), there is no evidence that the alleged invention of the patent in suit provided the answer to the problem. It is not claimed by plaintiffs that anyone other than defendant Consolidated, has ever adopted Garbell's suggestion to use such a wing, although he asserts that he published a technical paper describing the invention in the year 1946 [R. 291]. Can this Court believe that all of the aircraft flying today, other than the defendants' Convair Model 240, are unsafe and have dangerous stall characteristics? We suggest that such a thesis is, on its face, untenable.

We therefore submit that there is no evidence that there was any long-felt need in the art for the alleged invention of the patent in suit.

## The Alleged "Garbell Stall" Was Not Novel and Is Not Embodied in Defendants' Model 240.

Appellees' Brief (p. 6) baldly states that the patent in suit covers a wing which "has a totally new type of stall." Appellees' Brief (p. 38), however, admits that the 1937 "Pinguino" sailplane "accomplished this stall." Indeed, appellees could not well deny that the "Pinguino" accomplished such stall, as this is clearly established by the second Garbell patent which covers the "Pinguino" wing and which is printed as "Appendix C" to our Opening Brief (*see*: pp. 36-39 of our Op. Br.). It is therefore clear that the so-called "Garbell Stall" was *not* in fact novel with the patent in suit.

Appellees' Brief (p. 38) attempts to distinguish the patent in suit from the "Pinguino" wing by the allegation that "the wing of the Pinguino was not usable in a high-powered aircraft." This statement, we say, is belied by the second Garbell patent (App. C., Our Op. Br.), which covers the "Pinguino" wing and which states:

"This invention accomplishes an important improvement in the art and the discoveries herein disclosed are of great value *to all types of aircraft* (as well as to craft operating in other fluids), *throughout their entire operating range . . .*; also in violent maneuvers *at high speeds. . .*" (App. C, Col. 8, lines 58-68.)

We submit that the alleged "Garbell stall" was clearly old in the "Pinguino" which, of course, was fully described in printed publications long prior to the patent here in suit (see our Op. Br. p. 38), and that the "Pinguino"

wing structure, by Garbell's own admissions and representations in his second patent, was adapted for use in high-speed aircraft. There is therefore no novelty in the stall characteristics of the specific wing of the patent in suit.

Appellees' Brief (pp. 6-7) coins the term "Garbell Stall" to designate the type of stall alleged for the patent in suit, describing it as having the following special characteristics:

(a) In the Garbell stall, the flow of air over the upper surface of the wing first becomes turbulent over a large spanwise area of the lifting surface;

(b) Such initial turbulence is inboard of the lateral control devices;

(c) Such initial turbulence spreads inboardward therefrom;

(d) Such spread is characterized by a timely but not excessive stall warning through tail shake;

(e) Such tail shake occurs at a speed sufficiently but not excessively above the minimum level flying speed;

(f) Such spread is characterized by a substantial decrease in elevator control effectiveness as the aircraft approaches the stall;

(g) Such spread is characterized by a restoring pitching motion, nose down, with the absence of any excessive rolling motion prior to such restoring pitching motion;

(h) Such pitching motion being followed by the restoration of air speed necessary for sustained flight with only a small loss in altitude.

Appellees' Brief wholly fails to attempt to show where the evidence even tends to establish that defendants' Model 240 airplane operates to produce such a "Garbell Stall" as so defined by appellees. The reason for this failure in Appellees' Brief is obvious. There is no such evidence. Even Garbell failed to so testify.

### **Appellees' Dilemma as to Anticipation and Infringement.**

Appellees' Brief (pp. 11-12, 34) in effect charges that because the defendants' Convair Model 240 airplane includes all of the asserted structural elements of the claims in suit it infringes, regardless of whether the proofs show that such airplane has the same mode of operation and result of the patent in suit. Yet, appellees in effect assert that certain of the prior art does not anticipate the patent in suit because there is no evidence that such prior art had the same mode of operation and result as that ascribed to the patent in suit.

We have shown in our Opening Brief (pp. 50-57) that there was a total failure of proof by the plaintiffs as to any similarity of mode of operation or result of defendants' Model 240 airplane to that ascribed by the District Court's findings to the alleged invention of the patent in suit, and that, in fact, the Model 240 wing has an entirely different mode of operation and result. Our detailed an-

alysis of this issue is not answered by Appellees' Brief. Although Appellees' Brief (p. 34) represents that Garbell testified "that the stall of the Convair 240 was the same as the Garbell Stall [R. 442]," an examination of the record reference plainly shows that Garbell never so testified, in substance or effect.

We suggest that appellees are in the following dilemma, either that: (a) if similarity of structure alone, between the patent in suit and defendants' Model 240 airplane, is sufficient to spell out infringement, then, similarity of structure between the prior art of record and the patent in suit is alone sufficient to spell out anticipation and invalidity; or (b) if the burden was on defendants to establish that the prior-art structures had the same method of operation and result as that of the patent in suit, then a similar burden was on plaintiffs to show by clear and convincing evidence that defendants' Model 240 airplane has the same method of operation and result as the patent in suit. Since the claims in suit read structurally upon the prior art, as fully pointed out in our Opening Brief, and since there was a complete failure of proofs by plaintiffs to establish that the Convair 240 has the same mode of operation and result as the patent in suit, we suggest that the judgment must be reversed on either alternative of such dilemma.

## Appellees' Dilemma as to the Curtiss-Wright Airplanes.

Appellees do not seriously contend that the Curtiss-Wright airplanes, Models 19L, 23, and 21B, as shown by the evidence, did not include the identical wing geometry of the patent in suit. Indeed, there is no conflict of the evidence as to at least the Model 23 and 21B airplanes or their construction, as plaintiffs presented no evidence whatsoever with regard to them. Appellees' Brief (pp. 24-30), however, strenuously attacks the sufficiency of defendants' proofs on this subject, primarily attacking the oral testimony of the witness Oldendorph and its corroboration in the documentary exhibits.

It will be recalled that appellees rely solely upon the *wholly uncorroborated* oral testimony of Garbell in support of their contention that Garbell made the alleged invention of the patent in suit prior to his employ by defendant Consolidated.

Appellees, we suggest, are in the dilemma that either: (a) the oral testimony of Oldendorph, supported fully by the numerous exhibits in support thereof (see our Op. Br., pp. 39-42), is adequate to establish the fact of prior use of the Curtiss-Wright Airplanes and their wing construction; or (b) the oral and wholly uncorroborated testimony of Garbell is insufficient to establish conception of the invention by him prior to his employment by Consolidated. The standard as to the sufficiency of proof to carry back Garbell's alleged date of invention should be at least as high as the standard required for establishing a prior-art use of the invention. In fact, we suggest that the standard required of a patentee to carry back his date of invention should be far higher, as the temptation to perjury is considerably higher.

We submit that the testimony of Oldendorph fully supported by many documentary exhibits, including stipulated publications, the authenticity of which has not been questioned, is corroborative of these physical exhibits and is fully adequate to establish the fact of the Curtiss-Wright 19L, 23 and 21B airplanes, and the fact that they had identically the same camber and thickness relationships ascribed to the invention in suit.

### **Appellees' Dilemma as to Exhibit 25.**

Appellees' Brief (p. 15) relies upon Plaintiffs' Exhibit 25 to illustrate the proposal by Garbell to Consolidated of the invention in suit and its alleged rejection by Consolidated. The District Court similarly relied heavily upon Exhibit 25, saying: "The fullest disclosure of the patent invention . . . bears the final rejection in a pencilled notation, 'Not (interested) at this time.' (Plaintiffs' Exhibit 25)" [Memo. Dec., R. 40.]

Exhibit 25 discloses a wing in which the camber of the airfoil sections at the tip and interjacent sections are identical. This is one type of wing taught by the prior art. Therefore, either: (a) Exhibit 25 establishes that the alleged invention of the patent in suit is the same as the prior art, in which case the patent in suit is invalid; or (b) Exhibit 25 does not teach the invention of the patent in suit, in which case it does not support the District Court's finding of rejection of the invention by Consolidated, and the judgment on the license issue must fall. The facts establishing the dilemma are as follows:

Exhibit 25, in the tabulation [R. 667], shows "proposals" No. 6 and No. 2, by Garbell. Proposal No. 6

suggests airfoil section 63, 4-222 at the root, section 65, 3-518 at 60% span (the “interjacent” section), and section 65, 3-514 at the tip. Similarly, proposal No. 2 suggests airfoil section 63, 4-222 at the root, section 63, 4-518 at 60% span (the “interjacent” section), and section 63, 4-514 at the tip.

As pointed out by Garbell with regard to defendants' Model 240 airplane in suit, in the N.A.C.A. “63” series of airfoil sections, the fourth digit indicates the design lift coefficient (one way of saying camber)  $C_{li}$  and the fifth and sixth digits indicate thickness ratio in % [R. 221-225]. This is supported by Plaintiffs' Exhibit 21 [R. 653], and is made plain in Garbell's report, DX-A [R. 1007-1070]. It is also fully described in the affidavit of T. P. Hall as a conventional engineering convention for indicating the geometry of wing foil sections as set forth in N.A.C.A. Technical Report 824 [R. 80-81]. These facts cannot be honestly denied by appellees.

It is therefore plain that in Garbell's proposal No. 6 of Exhibit 25, the mean-line camber indicated by the fourth digit “5” is the same at the interjacent section (60% span) and the tip, and that the thickness ratio indicated by the last two digits decreases from root to tip as 22%, 18% and 14%. Similarly, as to proposal No. 2, the fourth digit “5” is the same at both the interjacent section (60% span) and tip, whereas the thickness ratio decreases from root to tip as 22%, 18% and 14%. This is fully confirmed by the Hall affidavit [R. 80]. In each proposal, the root section camber is indicated by the



fourth digit "2," showing that the camber at the root is less than that at the tip and interjacent section.

Since appellees assert that Garbell's such proposals No. 6 and No. 2 of Exhibit 25 constitute a disclosure of the "invention" of the patent in suit, it is plainly admitted by appellees in effect that the "invention" includes any wing in which the camber of the interjacent section is the *same* as that of the tip, and the thickness ratio decreases non-linearly from root to tip. This, of course, is directly confirmed in the patent in suit, which plainly states that the camber of the interjacent section may have "a value *equal to* or slightly less than" "that of the tip section" [Col. 7, lines 66-71, R. 611]. Appellees' Brief (pp. 22-23) plainly admits that such a construction is disclosed in the Royal Aeronautical Society article [DX-WW, R. 903] and in the Zien article [DX-XX, R. 911], and this is fully substantiated by Appellants' Opening Brief (pp. 32-34, and Plate IV).

It is therefore submitted that appellees' admissions and contentions plainly establish that the structure of the alleged invention in suit is taught by the prior art, and, we say, the patent in suit is clearly invalid thereover.

On the other hand, if appellees attempt to avoid the consequence of invalidity over the prior art by reversing their position and now contending that Exhibit 25 does not disclose the invention of the patent in suit, then, we say, there is no evidence to support the District Court's findings and holding that the "invention" was rejected by Consolidated, and the judgment must fall on this ground.

## There Was No Abandonment of the Infringement Defense.

Appellees' Brief (pp. 11-12) asserts that defendants "abandoned" the defense of infringement. This requires little reply, as, obviously, there was no such abandonment. Had defendants presented *no* evidence on the infringement question, they could still challenge the adequacy of plaintiffs' proofs on the issue.

Appellees' statement (p. 12) that "counsel for defendants have admitted the infringement of the patent in suit [Exhibit 21, R. 653]," is fallacious. At no time have counsel for defendants admitted infringement. Plaintiffs' Exhibit 21 [R. 653] referred to by Appellees' Brief shows on its face that it was written by Mr. D. A. Hall, who was in the Consolidated patent department [R. 326, 360]. Mr. Hall was not and never has been an attorney or counsel for Consolidated, as is well known to appellees' counsel. In any event, Exhibit 21 is not an admission of infringement, as it states: "*The teaching of the Garbell patent is not followed in the design of the Model 240 wing*" [R. 649].

Exhibit 21, additionally, positively establishes the fact that the stall of the Model 240 airplane is a *root stall*. It clearly states [R. 657] that: "the stall starts between the fuselage and the engine nacelle at about 15% semi-span outboard of the root section." An examination of the plan view of the Model 240 airplane shown in the drawing thereof [R. 1000], shows that on such drawing the distance between root and tip is about 2-23/32 inches. 15%

of this distance is about  $13/32$  inch, which, measured outwardly from the wing root, would locate the point of stall origin almost directly adjacent the fuselage. Obviously, the Model 240 has a *root stall*, as testified to by the expert Ward [R. 419].

### The License Issues.

Appellees' Brief does not deny our contention (Op. Br. pp. 22-24) that the alleged invention of the patent in suit was reduced to practice by Consolidated and its practicality fully demonstrated during the period of Garbell's employment. Appellees' Brief does not attempt to distinguish any of the authorities set forth in our Opening Brief (pp. 19-29) from the facts in the instant case or their application thereto, with the possible exception of the case of *Conway v. White*, 9 F. 2d 863 (C. C. A. 2d, 1925). The *Conway* case, however, supports our contention that an invention is "made" when it is reduced to practice, and appellees' brief does not contend otherwise. In particular, Appellees' Brief wholly fails to attempt to distinguish the case of *Hahn v. Venetian Blind Corp.*, 111 F. 2d 95 (C. C. A. 9th, 1940), which, we say, is directly in point on the issue as to when an invention is "made."

Appellees' Brief cites no contrary authority on the license issues, and, apparently, concedes that our statement of the relevant law is correct. Appellee cites *Pointer v. Six Wheel Corporation*, 177 F. 2d 153 (C. A. 9th, 1949). The question in that case was whether an invention was *joint* or *sole*. The Court held (p. 157): "Here the only basis for the claim of joint invention lies in the

fact that the Knox device was an addition to and improvement upon the Stebbins structure \* \* \*.” (P. 158): “Here there is no voluntary pooling of ideas. Knox’s suggestions were rejected by Stebbins.” Rejection of suggestions as disproving joint inventorship, is an entirely different question from and has no pertinency to the issue here.

We therefore submit that Appellees’ Brief fails to answer our contentions as to the law and its application to the facts here, and fails to show that the District Court’s findings on the license issue are supported in law or fact.

### **The Motion for a New Trial.**

We believe that we have carried appellants’ burden of establishing that the District Court’s findings as to infringement are clearly erroneous on the actual evidence in this action (Op. Br. pp. 50-57). If this Court has any doubt that we have carried such burden, we suggest that the case should be remanded for the production of the evidence offered by affidavit in our Motion for a New Trial, which plainly establishes lack of infringement.

The public, as well as the parties, have a real and serious interest in the outcome of this litigation, as it vitally affects a large segment of the commercial aviation industry. The issuance of an injunction would ground several hundred commercial Convair aircraft operated by defendant American and others, to the obvious great inconvenience and loss to the public. The Court of Appeals for the Third Circuit, in *Sutherland Paper Co. v. Grant Paper*

*Box Co.*, 183 F. 2d 926 (1950), in remanding a patent case for further proofs, aptly said:

“Judicial inability to deal adequately with complex patent litigation has been much decried. See, *e. g.*, Borkin, *The Patent Infringement Suit—Ordeal by Trial*, 17 U. Chi. L. Rev. 634, 641 (1950). The difficulties inherent in adjudication in this field afford an additional reason for withholding appellate decision on an issue which can receive more thorough consideration and exposition on a new trial. The public interest in the proper determination of this litigation, as well as the interests of the litigants, impels us to refrain from decision on the issue of validity until we are as fully informed as possible.”

From the District Court’s remarks at the trial, it was obvious to trial counsel that no continuance for the purpose of further proofs would be granted. This is illustrated by the remarks of the District Court, as follows:

“But if you insist on it, I will sustain the objection, but I *am not going* to take time to *adjourn* this case to have them produce that proof. I will give you *notice* of that *now*.” \* \* \* “Time is getting valuable. I will have you *out of here* today.” [R. 389.]

“But I am *not* going to continue this case in order for you to do that. This case will *finish today* as far as the proof is concerned.” [R. 395.]

We submit that in the absence of a full reversal in favor of defendants, this action should be remanded for further proofs.

## Garbell's Uncorroborated Testimony Is Insufficient to Carry Back His Date of Invention.

In an attempt to answer our contention that the uncorroborated, oral testimony of a patentee is insufficient to carry back his date of invention (Op. Br. p. 20), Appellees' Brief (p. 41) argues: (a) that, under Section 1844 of the California Code of Civil Procedure, the testimony of one witness, if believed, is sufficient to establish any fact; and (b) that Section 1844 is binding on this Court in this action, under 28 U. S. C. A., Section 1652, and *must* be followed as to the uncorroborated testimony of Garbell as to his date of invention. This argument is obviously without legal merit, and is indicative of the basic weakness of plaintiffs' case on the license issues.

This action is brought under the patent statutes of the United States [Complaint, Par. III(a), R. 4]. The fact in issue is *when* Garbell made the invention of the patent in suit. Both the action and the issue for decision are obviously exclusively Federal in nature. Under such circumstances, the Federal law governs, and this Court should ignore any state statute in conflict with the general body of Federal law. (See: *United States v. Standard Oil Co.*, 332 U. S. 301, 67 S. Ct. 1604, 91 L. Ed. 2067 (1946); *Garrett v. Moore-McCormack Co.*, 317 U. S. 239, 63 S. Ct. 246, 87 L. Ed. 239 (1942); *D'Oench, Duhme & Co. Inc. v. Federal Deposit Insurance Corp.*, 315 U. S. 447, 62 S. Ct. 676, 86 L. Ed. 956 (1942); *United States v. Lambeth*, 176 F. 2d 810 (C. A. 9th, 1949).)

Appellees' Brief makes no attempt to question our statement of the Federal law to the effect that the uncorroborated oral testimony of an inventor is insufficient, as a matter of law, to carry back his date of invention. We have cited a large number of cases to this effect in our Opening Brief (p. 20), and to the same effect, *see: T. II. Symington Co. v. National Malleable Castings Co.*, 250 U. S. 383, 39 S. Ct. 542, 63 L. Ed. 1045, at 1049 (1918).

It is respectfully submitted that the judgment should be reversed in its entirety.

Dated: February 28, 1952.

Respectfully submitted,

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